

**REMARKS**

Claims 1-13 are pending. No amendments have been made by way of the present submission, thus, no new matter has been added. Additionally, no new issues have been raised which would require additional search and/or consideration on the part of the Examiner.

In the event that the present submission does not place the application into condition for allowance, entry thereof is respectfully requested as placing the application into better form for appeal.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

**Issues under 35 U.S.C. §103(a)**

The Examiner has rejected claims 1-13 under 35 U.S.C. §103(a) as being obvious over Curtze et al., USP 5,945,567 (hereinafter referred to as Curtze '567) in view of Rose et al., USP 6,576,595 (hereinafter referred to as Rose '595) and Rains et al., USP 5,476,970 (hereinafter referred to as Rains '970). Applicants respectfully traverse this rejection.

Applicants submit that the Rose '595 reference should be excluded as prior art to the present application. For instance, Rose '595 (as cited in the Examiner's 35 U.S.C. §103(a) rejection) qualifies as prior art under 35 U.S.C. §102(e)/103(a) as of the U.S. filing date of September 23, 2002 and under 35 U.S.C. §102(a)/103(a) as of the grant date of June 10, 2003. However, Applicants submit that Rose '595 does not qualify as prior art under either 35 U.S.C. § 102(e) or §102(a).

Concerning the possible citation of Rose '595 under 35 U.S.C. §102(e)/103(a), Applicants point out that a reference available as prior art under 35 U.S.C. §102(e) can be disqualified under

35 U.S.C. §103(c) if such reference is used in a §103(a) rejection, provided that the subject matter (of the cited reference) and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. In the present instance, both Rose '595 and the presently claimed invention were, at the time the invention was made, subject to an obligation of assignment to BASF Aktiengesellschaft. Therefore, Rose '595 should be excluded as prior art under the above analysis.

As evidence of common ownership at the time the invention was made, Applicants provide herewith the assignment records for the present application and for the application which led to the Rose '595 patent.

Concerning the citation of Rose '595 under 35 U.S.C. §102(a)/103(a), Applicants note that Rose '595 granted on June 10, 2003. From a review of the patent family of Rose '595, Applicants have also identified, in the patent family of Rose '595, two corresponding publications, which are EP 1 295 877 A1 (published March 26, 2003) and JP2003-201289 (published July 18, 2003), front pages attached. Assuming all disclosures to be identical, Rose '595 as well as these two corresponding publications appear to qualify as prior art under 35 U.S.C. §102(a)/103(a) against the present application as of their respective grant or publication dates.

However, the present application claims priority to German application DE 10258669.1, filed December 13, 2002, which predates each of these grant or publication dates. Attached hereto is a verified English language translation of the German priority application DE 10258669.1. Since the present claims are fully supported therein, Applicants have perfected their right to the date of December 13, 2002, which is the filing date of DE 10258669.1. Therefore,

any dates possibly raised under 35 U.S.C. §102(a)/103(a) in the family of Rose '595 are removed.

In view of the above, the disclosure of Rose '595 is not prior art to the present application. The Examiner's rejection therefore fails and should be withdrawn.

However, ignoring the above deficiency in the Examiner's rejection, Applicants submit that the present claims are still patentable and therefore herein incorporate all previously submitted arguments. Additionally, Applicants take this opportunity to address issues raised by the Examiner in the outstanding Office Action.

Applicants request that the Examiner specifically consider a point raised in the previous response. In particular, by utilizing each of the presently claimed process parameters, it has been surprisingly found that, within the framework of the present invention, substantial advantages can be achieved in the preparation of benzophenones, such as shorter reaction times at high yields. A further advantage of the present process is that, in contrast to known processes, it is possible to only synthesize the wanted triclinic form of the compounds. Known processes result in unwanted mixtures from usually two modifications (see present application, page 4, lines 16 to 19).

Applicants have already provided numerous arguments to support the fact that the Examiner has failed to present a *prima facie* case of obviousness. However, the above point is important to consider since according to the present invention, as compared to known processes, it is possible to synthesize only the wanted triclinic form of the compounds, whereas known processes result in unwanted mixtures. These results are completely unexpected based upon the prior art and thus rebut any hypothetical *prima facie* case of obviousness.

Application No. 10/535,710  
Amendment dated March 23, 2007  
Reply to Office Action of August 2, 2006

Docket No.: 4266-0125PUS1


In view of the above, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: March 23, 2007

Respectfully submitted,

By 

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Attachments: USPTO Assignment Records for Rose '595 and present application,  
Front pages from EP 1 295 877 A1 and JP2003-201289 A, and  
Verified English translation of DE 102 58 669.1



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## Assignments on the Web &gt; Patent Query

## Patent Assignment Abstract of Title

***NOTE: Results display only for issued patents and published applications.  
For pending or abandoned applications please consult USPTO staff.***

## Total Assignments: 1

**Patent #:** 6576595    **Issue Dt:** 06/10/2003    **Application #:** 10251783    **Filing Dt:** 09/23/2002**Inventors:** Ingo Rose, Jordi Tormo i Blasco, Markus Gewehr, Wassilios Grammenos, Bernd Muller et al**Title:** XANTHONE DERIVATIVES, PROCESSES FOR THEIR PREPARATION AND THEIR USE FOR CONTROLLING HARMFUL FUNGI, AND COMPOSITIONS COMPRISING THESE DERIVATIVES

## Assignment: 1

**Reel/Frame:** 013319/0508**Recorded:** 09/23/2002**Pages:** 3**Conveyance:** ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).**Assignors:** ROSE, INGO**Exec Dt:** 08/08/2002BLASCO, JORDI TORMO I**Exec Dt:** 08/08/2002GEWEHR, MARKUS**Exec Dt:** 08/08/2002GRAMMENOS, WASSILIOS**Exec Dt:** 08/08/2002MUELLER, BERND**Exec Dt:** 08/08/2002RHEINHEIMER, JOACHIM**Exec Dt:** 08/08/2002SCHAEFER, PETER**Exec Dt:** 08/08/2002SCHIEWECK, FRANK**Exec Dt:** 08/08/2002GROTE, THOMAS**Exec Dt:** 08/08/2002GYPSE, ANDREAS**Exec Dt:** 08/08/2002AMMERMANN, EBERHARD**Exec Dt:** 08/08/2002LORENZ, GISELA**Exec Dt:** 08/08/2002STIERL, REINHARD**Exec Dt:** 08/08/2002STRATHMANN, SIEGFRIED**Exec Dt:** 08/08/2002**Assignee:** BASF AKTIENGESELLSCHAFT

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## Patent Assignment Details

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Reel/Frame: 017016/0122

Page:

Recorded: 05/20/2005

Attorney Dkt #: 5000-0124PUS1

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

## Total properties: 1

1 Patent #: NONE Issue Dt: Application #: 10535710 Filing Dt: 05/20/2  
Publication #: US20060009659 Pub Dt: 01/12/2006  
Title: Method for the production of benzophenonen

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(19)



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(11)

**EP 1 295 877 A1**

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**EUROPÄISCHE PATENTANMELDUNG**

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35 U.S.C. § 102(a)

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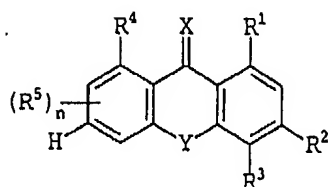
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(54) **Xanthonderivate, Verfahren zu ihrer Herstellung und ihre Verwendung zur Bekämpfung von Schadpilzen sowie sie enthaltende Mittel**

(57) Xanthonderivate der Formel I



I

in der der Index und die Variablen folgende Bedeutung haben

n 0, 1 oder 2;

R<sup>1</sup> Alkyl oder Halogenalkyl;

R<sup>2</sup>, R<sup>3</sup> Alkoxy, Alkenyloxy oder Alkinyloxy,  
oder R<sup>2</sup> und R<sup>3</sup> bilden gemeinsam eine ggf. subst. Oxy-alkylenoxygruppe;

R<sup>4</sup> Halogen, Cyano, Hydroxy, Amino, Mercapto, Alkyl, Halogenalkyl, Alkoxy, Halogenalkoxy, Alkylthio, Halogenalkylthio, Alkylcarbonyloxy oder Alkylcarbonylthio;

R<sup>5</sup> eine Gruppe R<sup>4</sup>, wobei die Gruppen R<sup>5</sup> verschieden sein können, wenn n=2 ist;

EP 1 295 877 A1

(19) 日本国特許庁 (J P)

(12) 公開特許公報 (A)

(11) 特許出願公開番号

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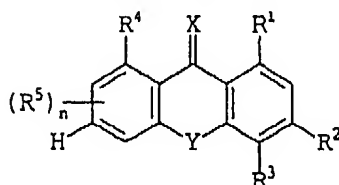
弁理士 平木 祐輔 (外2名)

最終頁に続く

(54) 【発明の名称】 キサントン誘導体、それらの製造方法及び有害な真菌を防除するためのそれらの使用、並びに該誘導体を含む組成物

(57) 【要約】 (修正有)

【課題】 有害な植物病原性真菌類の防除のために有効な化合物、該化合物の製造方法、該化合物を含む組成物及びその使用方法の提供。

【解決手段】 式I(式中、置換基および変数は本文に示す通り定義される：nは、0、1又は2であり；R<sup>1</sup>は、アルキル等であり；R<sup>2</sup>、R<sup>3</sup>は、アルコキシ等であり、又は、R<sup>2</sup>とR<sup>3</sup>とが一緒になって、無置換の又は置換されたオキシアルキレンオキシ基を形成しており；R<sup>4</sup>は、ハロゲン等であり；R<sup>5</sup>は、基R<sup>4</sup>であり、nが2である場合は異なってもよく；X、Yは、酸素又は硫黄である]で表されるキサントン誘導体、並びに、該化合物の製造方法、それらを含む組成物及び有害な植物病原性真菌類の防除のためのそれらの使用。

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